

REMARKS

This responds to the Non-Final Office Action dated October 23, 2008 (hereinafter "Office Action"). Claims 1, 4, 5, 9, 10, 12, 21 and 22 are currently amended and fully supported by the above-identified application as filed, such as at page 3, lines 16-18; page 4, lines 15-17; page 6, line 25 – page 7, line 6; page 7, lines 13-21; page 7, line 24 – page 8, line 8; page 8, lines 23-28; and FIGS. 1-6. Claim 2 was previously cancelled without prejudice or disclaimer. Claim 25 is new. Accordingly, claims 1 and 3-25 are currently pending and responded to below.

Applicants hereby respectfully request further examination and reconsideration of this application in view of the foregoing claim amendments and following remarks.

Request for Telephonic Interview

1. If the present amendments and remarks do not result in allowance of all claims, Applicants kindly request a telephonic interview between the Examiner and Applicants' representative, Gregory Smock, to help expedite examination. As noted below, Applicants' representative can be reached by telephone at (612) 373-6956.

§102 Rejection of the Claims

2. Claims 1, 3-8, 10, 11, 13, 14 and 17-22 were rejected under 35 U.S.C. § 102(e) for assertedly being anticipation by Castellano (U.S. Patent No. 6,223,786). Applicants respectfully request reversal of this rejection on the ground that Castellano fails to recite each element of the claims, as amended.

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 200 USPQ 303, 313 (Fed. Cir. 1983). In addition, the prior art reference must disclose each element of the claimed invention “arranged as in the claim.”¹

¹ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))(emphasis added).

Claim 1:

Claim 1 presently recites a coupling syringe system comprising, among other things, a first syringe including a first syringe tip with an integral male end portion and a locking ring, “wherein the locking ring is spaced from an outer surface of the male end portion.” When coupled to a second syringe including an integral female end portion having an opening defined by an opening wall, the spacing between the locking ring and the outer surface of the male end portion “receives the opening wall” to provide a fluid tight attachment site.

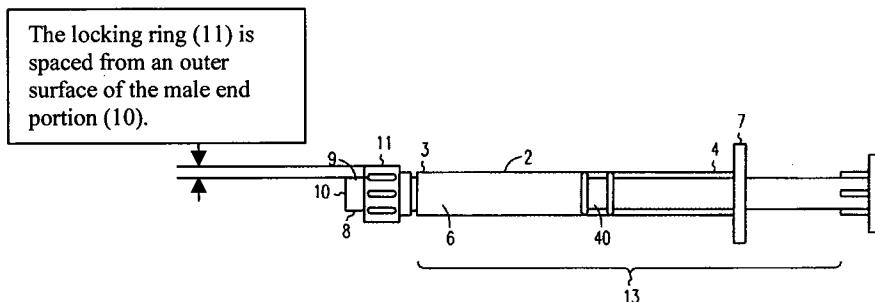


FIG. 4

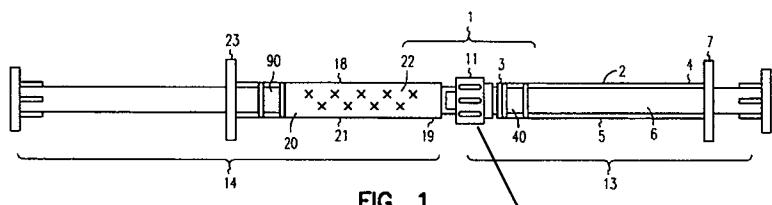


FIG. 1

The spacing between the locking ring (11) and the outer surface of the male end portion (10) receives an opening wall defining an opening of the female end portion.

In contrast to what is claimed by Applicants, Castellano teaches an asserted male end portion (22) having a locking ring (20) attached directly to an outer surface of the male end portion. (See Office Action at page 2.) For example, see FIG. 6 of Castellano below:

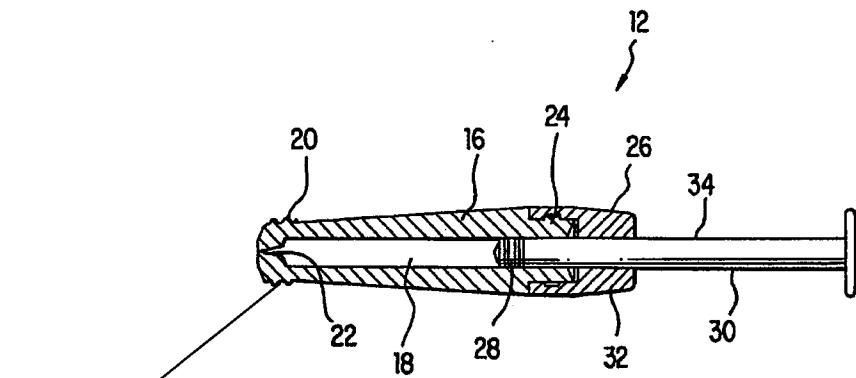


FIG. 6

The locking ring (20) is integrated with, and attaches directly to, an outer surface of the male end portion (22), in contrast to Applicants' claimed spacing between the locking ring and the outer surface of the male end portion.

Because Castellano does not recite a coupling syringe system comprising a first syringe including a first syringe tip with an integral male end portion and a locking ring, "wherein the locking ring is spaced from an outer surface of the male end portion," nor the "receipt of an opening wall" of a second syringe's female end portion by such spacing, as recited in Applicants' claim 1, Castellano cannot anticipate claim 1. Claims 3-20 are dependent on claim 1 and are patentable over Castellano for at least the reasons stated above, in addition to the elements recited in such dependent claims.

Reconsideration and allowance of claims 1 and 3-20 are respectfully requested.

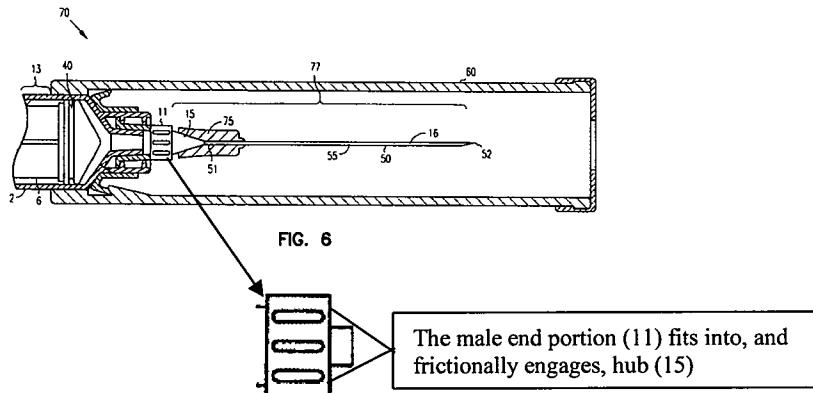
Claim 4:

Additionally, regarding claim 4, Applicants cannot find in Castellano any recitation of a "male end portion" of a syringe configured to "at least partially fit[] into, and frictionally engage[]]" a needle hub when a discharge assembly and a locking ring are detachably connected.

Serial Number: 10/634,656

Filing Date: August 5, 2003

Title: COUPLING SYRINGE SYSTEM AND METHODS FOR OBTAINING A MIXED COMPOSITION



In contrast, the Office Action asserts that a “female end portion” of a syringe is capable of the claimed connection to a needle assembly. (*See* Office Action at pages 2-3.) However, a female end portion, since it is a depression and not a protrusion, is not capable of fitting into and frictionally engaging a needle hub.

Because Castellano does not recite a “male end portion” of a syringe, which is configured to “at least partially fit into and frictionally engage” a needle hub, as presently recited in Applicants’ claim 4, Castellano cannot anticipate claim 4.

Reconsideration and allowance of claim 4 is respectfully requested.

Claim 5:

Additionally, regarding claim 5, Applicants cannot find in Castellano any recitation of an engagement between one or more exteriorly protruding members of a female end portion and one or more threads on “an inward-oriented surface of [a] locking ring, which extend toward a syringe axis.” In contrast, the asserted locking ring (20) of Castellano includes threads on an outward-oriented surface, which extend away from a syringe axis. (*See* Office Action at page 2.) For example, see FIG. 6 of Castellano below:

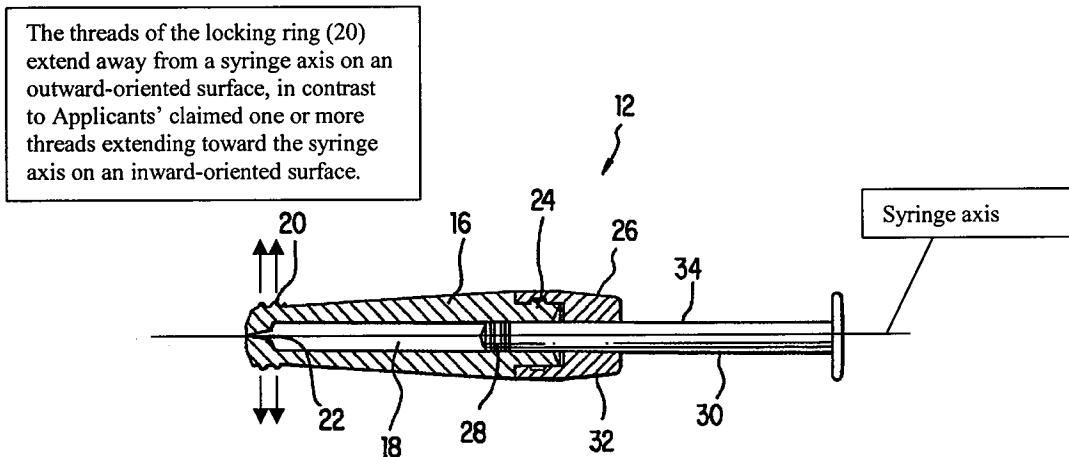


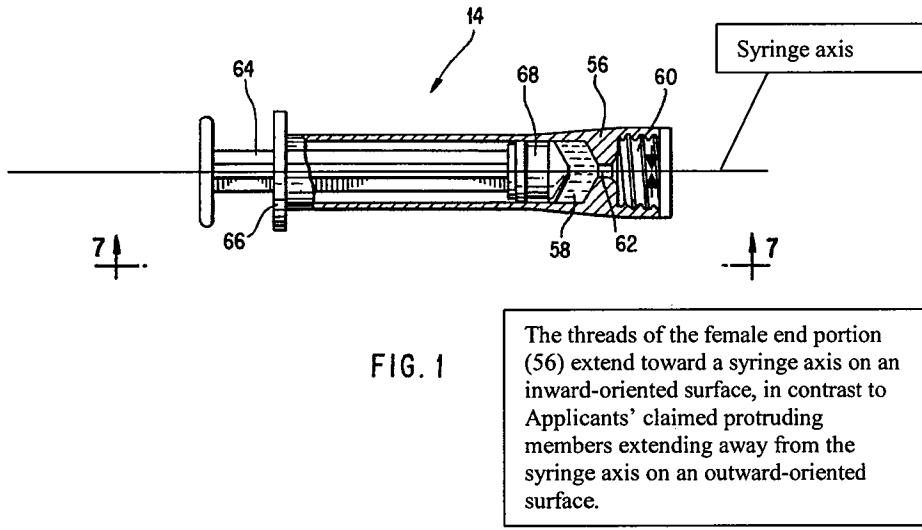
FIG. 6

Because Castellano does not recite an engagement between one or more exteriorly protruding members of a female end portion and one or more threads on “an inward-oriented surface of the locking ring, which extend toward a syringe axis,” as presently recited in Applicants’ claim 5, Castellano cannot anticipate claim 5.

Reconsideration and allowance of claim 5 is respectfully requested.

Claim 10:

Additionally, regarding claim 10, Applicants cannot find in Castellano any recitation of an engagement between one or more exteriorly protruding members of a female end portion, which are “disposed on an outward-oriented surface of [an] opening wall away from a syringe axis,” and a locking ring surrounding a male end portion. In contrast, the asserted female end portion (56) of Castellano includes threads on an inward-oriented surface, which extend toward a syringe axis. (See Office Action at page 3.) For example, see FIG. 1 of Castellano below:



Because Castellano does not recite an engagement between one or more exteriorly protruding members of a female end portion, which are “disposed on an outward-oriented surface of [an] opening wall away from a syringe axis,” and a locking ring surrounding a male end portion, as presently recited in Applicants’ claim 10, Castellano cannot anticipate claim 10.

Reconsideration and allowance of claim 10 is respectfully requested.

Claim 21:

Claim 21 presently recites a coupling syringe system comprising, among other things, a first syringe including a first syringe tip with an integral male end portion and a locking ring, “wherein the locking ring is spaced from an outer surface of the male end portion.” When coupled to a second syringe including an integral female end portion having an opening defined by an opening wall, the spacing between the locking ring and the outer surface of the male end portion “receives the opening wall” to provide a fluid tight attachment site. To this end, Applicants hereby incorporate by reference the relevant remarks asserted above with respect to claim 1 (i.e., in contrast to what is claimed by Applicants, Castellano teaches an asserted male end portion (22) having a locking ring (20) attached directly to an outer surface of the male end portion).

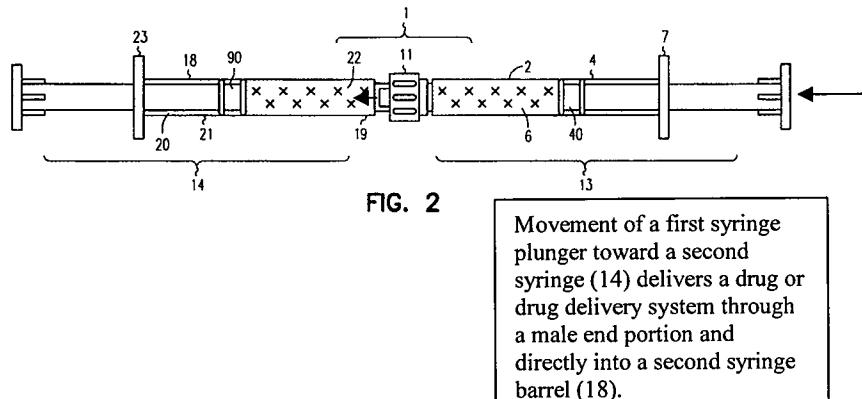
Because Castellano does not recite a coupling syringe system comprising a first syringe including a first syringe tip with an integral male end portion and a locking ring, “wherein the locking ring is spaced from an outer surface of the male end portion,” nor the “receipt of an

opening wall” of a second syringe’s female end portion by such spacing, as recited in Applicants’ claim 21, Castellano cannot anticipate claim 21. Claims 22-25 are dependent on claim 21 and are patentable over Castellano for at least the reasons stated above, in addition to the elements recited in such dependent claims.

Reconsideration and allowance of claims 21-25 are respectfully requested.

Claim 25:

Additionally, regarding claim 25, Applicants cannot find in Castellano any recitation of a coupling syringe system wherein, when a first and second syringe are coupled, movement of a first syringe plunger toward the second syringe delivers a drug or drug delivery system “through [a] male end portion and directly into [a] second syringe barrel.”



In contrast to what is claimed by Applicants, Castellano teaches a coupling syringe system wherein, with a first and second syringe are coupled, movement of a first syringe plunger (30) delivers a diluent through an asserted male end portion (22), then through an intermediate channel (62), and finally into a second syringe barrel. (See Office Action at pages 2-3.) For example, see FIG. 7 of Castellano below:

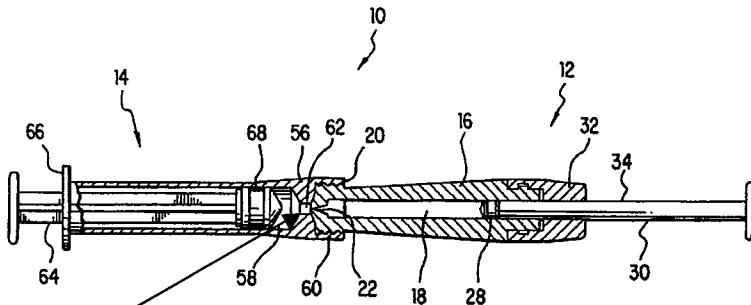


FIG. 7

As pointed out in Applicants' application, intermediate coupling means, such as channel (62), undesirably provides a space where there is very little agitation due to plug flow of contents and leads to waste if not aspirated out. (See Application at page 2, lines 3-7.)

Because Castellano does not recite a coupling syringe system wherein, when a first and second syringe are coupled, movement of a first syringe plunger toward the second syringe delivers a drug or drug delivery system "through [a] male end portion and directly into [a] second syringe barrel," as recited in Applicants' claim 25, Castellano cannot anticipate claim 25.

Reconsideration and allowance of claim 25 are respectfully requested.

§103 Rejection of the Claims

3. Claims 15, 16, 23 and 24 were rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Castellano, as applied above.

Claims 15-16 and 23-24 depend respectively on claims 1 and 21, and are believed to be allowable for at least the reasons provided above with respect to such claims. Reconsideration and allowance of claims 15, 16, 23 and 24 are respectfully requested.

4. Claims 9 and 12 were rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Castellano in view of Kanno (U.S. Patent No. 4,629,455). Applicants respectfully request reversal of this rejection on the ground that there is no *prima facie* case of obviousness for the claims.

Claims 9 and 12 depend on claim 1, and are believed to be allowable for at least the reasons provided above with respect to such claim. Reconsideration and allowance of claims 9 and 12 are respectfully requested.

Reservation of Rights

5. In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, or the right to swear behind any cited reference, such as provided under 37 C.F.R. § 1.131 or otherwise. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited and encouraged to telephone Applicants' representative at (612) 373-6956 to facilitate prosecution of this application.

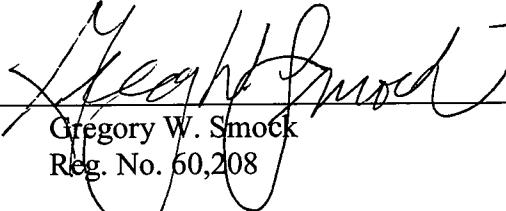
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6956

Date JANUARY 19, 2009

By


Gregory W. Smock
Reg. No. 50,208

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 19, 2009.

Dawn M. Boie

Name

Dawn M. Boie

Signature